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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166
20350	7590	10/20/2005	EXAMINER DIXON, THOMAS A	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ART UNIT 3639	
PAPER NUMBER				

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/027,696	<b>Applicant(s)</b> VILLAPUDUA, MISSY L.	
	<b>Examiner</b> Thomas A. Dixon	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's arguments, see remarks, filed 8/25/04, with respect to the data collection previous to the issuance of the payment instrument has been fully considered and are persuasive. The finality of rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in further view of O'Flaherty et al (6,275,824).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter (2002/0087472) in view of O'Flaherty et al (6,275,824).

As per Claim 1.

Walter (824) discloses a method for protecting consumer personal data, comprising:

receiving an application for a payment instrument (e.g. smart card, credit card or loyalty card in Fig. 3 and paragraph (0025)), wherein the application comprises personal data and a privacy preference of a consumer (see paragraph (0045), see Fig. 4);

saving the application in a database (see Figs. 1 and 5) that is associated with an issuing financial institution Who issued the payment instrument (See paragraph (0044) for the inherent financial institution, which is issuing the card;

storing at least some of the personal data and the privacy preference onto the payment instrument, wherein the payment instrument includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account that is associated with the issuing financial institution (see paragraphs (0025), (0036)-(00381); and

receiving a purchase request at a credit or debit processing system that is associated with a merchant financial institution, wherein the purchase request is in response to presentation of the payment instrument and the customer account

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information and at least some of the personal data and the privacy preference (see paragraphs (0012)-(0013), EO036)-(0038), (0040J, (0044J); and

saving the privacy preference in a database associated with the merchant financial institution (28) (see Id.),

wherein the purchase request provides the consumer account information as well as the personal data and the privacy preference from the user of the payment instrument, without separate entry of the personal data and the privacy preference from an instrument other than the payment instrument (see Supra paragraphs).

Walter (824) does not disclose the application is received before the payment instrument is issued.

O'Flaherty et al (824) teaches entering privacy preferences at a kiosk before issuance of a card, see column 5, lines 1-9 for the benefit of expediting issuance of a card.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide a kiosk to collect data for the issuance of a card for the benefit of expediting issuance of a card.

As per Claims 2 and 4:

Walter (824) further discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Supra paragraphs).

As per Claim 3:

Walter (824) further discloses the method, wherein the payment instrument includes a check, and wherein the privacy preference is printed onto the check (see Supra paragraph (0025)).

As per Claim 5:

Walter (824) further discloses the method including the step of reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see paragraphs (00121)-(0013), (0036J)-(0038), (0040), (0044)).

As per Claim 6:

Walter (824) further discloses the method including the step of mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see paragraph (0003)).

As per Claims 7-8:

Walter (824) further discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (see paragraphs (0003), (0006) by controlling the type of personal data that may be collected).

As per Claim 9:

Walter (824) further discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (Id.).

As per Claim 10:

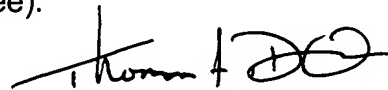
Walter (824) further discloses the method, wherein the privacy preference indicates that the consumer opts out (see paragraph (0008)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3639

October 05